

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	<b>MAIL STOP</b>
Takeo Katsuda	)	
Application No.: 09/880,039	)	Group Art Unit: 2454
Filed: June 14, 2001	)	Examiner: THOMAS DUONG
For: APPARATUS, PORTABLE	)	Confirmation No.: 5950
TERMINAL UNIT, AND SYSTEM	)	
FOR CONTROLLING E-MAIL, AND	)	
ITS METHOD, COMPUTER-	)	
READABLE RECORDING MEDIUM	)	
AND PROGRAM PRODUCT FOR	)	
PROCESSING E-MAIL	)	

**AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Decision on Appeal of the Board of Patent Appeals and Interferences dated July 6, 2011, please amend the above-identified patent application as follows:

**AMENDMENTS TO THE CLAIMS:**

This listing of claims will replace all prior versions, and listings, of claims in the application:

**LISTING OF CLAIMS:**

Claims 1-13. (Canceled).

14. (Previously Presented): An E-mail controlling apparatus comprising:
- an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;
  - an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;
  - an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;
  - an instruction receiving device receiving an E-mail including an instruction for specifying one of multiple image output devices;
  - a converting device converting the attachment file portion into data of a format acceptable to the image output device; and
  - a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.

15. (Previously Presented): An E-mail controlling system comprising:
- an E-mail receiving device receiving E-mail addressed to a portable terminal unit;

an E-mail preparing device preparing receipt notice E-mail based on the E-mail received by said E-mail receiving device;

an E-mail transmitting device transmitting the receipt notice E-mail prepared by said E-mail preparing device to said portable terminal unit;

a location information acquiring device acquiring location information of said portable terminal unit;

a selecting device selecting one of multiple image output devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device;

a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device; and

a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device.

16. (Previously Presented): The E-mail controlling system according to claim 15 wherein said E-mail preparing device prepares the receipt notice E-mail based on the content of a main text portion of the E-mail received by the E-mail receiving device.

17. (Previously Presented): The E-mail controlling system according to claim 15 wherein said E-mail preparing device prepares the receipt notice E-mail by removing an attachment file portion of the E-mail received by the E-mail receiving device.

18. (Previously Presented): The E-mail controlling system according to claim 17 wherein said data transmitting device transmits data corresponding to the attachment file portion of the E-mail received by the E-mail receiving device.

19. (Previously Presented): The E-mail controlling system according to claim 18 further comprising a converting device converting the attachment file portion of the E-mail received by the E-mail receiving device into data of a format acceptable to the image output device; wherein,

said data transmitting device transmits the data after the conversion by said converting device.

20. (Previously Presented): The E-mail controlling system according to claim 15 wherein said data transmitting device transmits data corresponding to an attachment file portion of the E-mail received by the E-mail receiving device.

21. (Previously Presented): The E-mail controlling system according to claim 15 wherein said data transmitting device transmits the data corresponding to the entire portion of the E-mail received by the E-mail receiving device.

22. (Previously Presented): The E-mail controlling system according to claim 15 wherein said selecting device selects image output devices within a certain distance from said portable terminal unit.

23. (Previously Presented): The E-mail controlling system according to claim 15 wherein said selecting device selects an image output device closest to said portable terminal unit.

24. (Previously Presented): The E-mail controlling system according to claim 15 wherein said selecting device includes:

- a memory device storing location information of multiple image output devices; and
- a search device searching image output devices suitable for the location information acquired by said location information acquiring device from multiple image output devices whose location information is stored in said memory device.

25. (Previously Presented): The E-mail controlling system according to claim 15 wherein said selecting device includes:

- a list preparing device preparing a list of image output devices within a certain distance from said portable terminal unit;
- a list transmitting device transmitting the list prepared by said list preparing device to said portable terminal unit; and
- a selection instruction receiving device receiving an instruction specifying one of the image output devices in the list.

26. (Previously Presented): The E-mail controlling system according to claim 15 wherein said data transmitting device transmits the data to an image output device specified by an IP address.

27. (Previously Presented): The E-mail controlling system according to claim 15 wherein said data transmitting device transmits the data to an image output device specified by a telephone number.

28. (Previously Presented): The E-mail controlling system according to claim 15 wherein communication between said E-mail transmitting device and said portable terminal unit is conducted indirectly via another E-mail controlling system.

29. (Previously Presented): The E-mail controlling system according to claim 15 wherein said data transmitting device transmits at least a portion of the data of the E-mail received by the E-mail receiving device to a display selected by the selecting device.

30. (Previously Presented): The E-mail controlling system according to claim 15 wherein said data transmitting device transmits at least a portion of the data of the E-mail received by the E-mail receiving device to a printer.

31. (Previously Presented): An E-mail controlling system comprising:  
an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;  
an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;  
an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;

an instruction receiving device receiving an E-mail including an instruction specifying one of multiple image output devices;

a converting device converting the attachment file portion into data of a format acceptable to the image output device; and

a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.

Claims 32 – 36. (Canceled).

37. (Previously Presented) An E-mail controlling system comprising: an E-mail controlling apparatus; a portable terminal unit receiving E-mail from said E-mail controlling apparatus; and an image output device capable of receiving data from said E-mail controlling apparatus;

said E-mail controlling apparatus including: an E-mail receiving device receiving E-mail addressed to said portable terminal unit; an E-mail preparing device preparing receipt notice E-mail based on the E-mail received by said E-mail receiving device; an E-mail transmitting device transmitting the receipt notice E-mail prepared by said E-mail preparing device to said portable terminal unit; a location information acquiring device acquiring location information of said portable terminal unit; a selecting device selecting one of multiple image output devices on the basis of the location information of said portable terminal unit acquired by said position acquiring device; a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device; and a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device;

said image output device outputting the content of the E-mail based on the data received from said E-mail controlling apparatus.

38. (Previously Presented) An E-mail processing method comprising the steps of:  
receiving E-mail addressed to a certain destination;  
preparing receipt notice E-mail based on the received E-mail;  
transmitting said receipt notice E-mail to said destination;  
acquiring location information of said destination;  
selecting one of multiple image output devices on the basis of the location information of said destination acquired;  
sending an E-mail to said destination containing a notification of the selected image output device; and  
transmitting at least a portion of the data of the received E-mail to the selected image output device.

39. (Previously Presented) An E-mail processing method comprising the steps of:  
receiving E-mail addressed to a portable terminal unit;  
preparing receipt notice E-mail based on the received E-mail;  
transmitting said receipt notice E-mail to said portable terminal unit;  
acquiring location information of said portable terminal unit;  
selecting one of multiple image output devices on the basis of the acquired location information of said portable terminal unit;  
sending an E-mail to said portable terminal unit containing a notification of the selected image output device; and



transmitting at least a portion of the data of the received E-mail to the selected image output device.

40. (Previously Presented) A computer-readable medium having a plurality of sequences of instructions stored thereon including sequences of instructions which are executed by one or more processors to perform the steps of:

- receiving E-mail addressed to a certain destination;
- preparing receipt notice E-mail based on the received E-mail;
- transmitting said receipt notice E-mail to said destination;
- acquiring location information of said destination;
- selecting one of multiple image output devices on the basis of the location information of said destination acquired;
- sending an E-mail to said destination containing a notification of the selected image output device; and
- transmitting at least a portion of the data of the received E-mail to the selected image output device.

41. (Previously Presented) A computer-readable medium having a plurality of sequences of instructions stored thereon including sequences of instructions which are executed by one or more processors to perform the steps of:

- receiving E-mail addressed to a portable terminal unit;
- preparing receipt notice E-mail based on the received E-mail ;
- transmitting said receipt notice E-mail to said portable terminal unit;
- acquiring location information of said portable terminal unit;

selecting one of multiple image output devices on the basis of the acquired location information of said portable terminal unit;

sending an E-mail to said portable terminal unit containing a notification of the selected image output device; and

transmitting at least a portion of the data of the received E-mail to the selected image output device.

42. (Previously Presented) A program product comprising:  
a computer-readable medium; and  
computer program contained on said computer-readable medium for causing a computer to execute a process comprising the steps of:  
receiving E-mail addressed to a certain destination;  
preparing receipt notice E-mail based on the received E-mail;  
transmitting said receipt notice E-mail to said destination;  
acquiring location information of said destination;  
selecting one of multiple image output devices on the basis of the location information of said destination acquired;  
sending an E-mail to said destination containing a notification of the selected image output device; and  
transmitting at least a portion of the data of the received E-mail to the selected image output device.

43. (Previously Presented) A program product comprising:  
a computer-readable medium; and

computer program contained on said computer-readable medium for causing a computer to execute a process comprising the steps of:

- receiving E-mail addressed to a portable terminal unit;
- preparing receipt notice E-mail based on the received E-mail;
- transmitting said receipt notice E-mail to said portable terminal unit;
- acquiring location information of said portable terminal unit;
- selecting one of multiple image output devices on the basis of the acquired location information of said portable terminal unit;
- sending an E-mail to said portable terminal unit containing a notification of the selected image output device; and
- transmitting at least a portion of the data of the received E-mail to the selected image output device.

Claims 44. - 46 (Cancelled)

47. (Previously Presented): The e-mail controlling system of claim 15, wherein said selecting device automatically selects one of said multiple image devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device.

### **REMARKS**

This communication is a full and timely response to the aforementioned Decision on Appeal of the Board of Patent Appeals and Interferences dated July 6, 2011. Claims 14-31, 37-43, and 47 remain pending in the application, of which claims 15-30, 37, 39, 41, 43, and 47 are allowed. By this communication, claims 44-46 are cancelled. Claims 14-31, 37-43, and 47 are not amended. Reconsideration and allowance of the application are respectfully requested in view of the foregoing Amendments and the following Remarks.

#### **Decision On Appeal**

Claims 14 and 31 were rejected under 35 U.S.C. §102(b) as being anticipated by US006421707 to Miller et al ("*Miller*").

Claims 38, 40, 42, and 44-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Miller* in view of US005493692 to Theimer et al. ("*Theimer*").

In the Decision on Appeal, the Board of Appeals sustained the rejections of claims 44-46, and reversed the rejections of claims 14, 31, 38, 40, and 42.

Without acquiescing to the rejections of claims 44-46, and without prejudicing Applicants' right to pursue the subject matter of these claims in an appropriate continuation application, claims 44-46 have been cancelled to expedite allowance of the application.

Accordingly, claims 14-31, 37-43, and 47 are the only claims remaining in the application, of which claims 15-30, 37, 39, 41, and 43 are allowed and the rejections of claims 14, 31, 38, 40, and 42 having been reversed by the Board of Appeals.

Therefore, Applicants respectfully submit that that the present application is clearly in condition for allowance and a notice to that effect is respectfully solicited.

If, after reviewing this Amendment, the Examiner believes there are any issues remaining which must be resolved before the application can be passed to issue, the

Examiner is respectfully requested to contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,  
BUCHANAN INGERSOLL & ROONEY PC

Date: September 6, 2011

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